

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)
	10/552,152	TANIGUCHI ET AL.
	Examiner	Art Unit
	MELANIE J. HAND	3761

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 December 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) The period for reply expires 3 months from the mailing date of the final rejection.
- b) The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

- (a) They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) They raise the issue of new matter (see NOTE below);
- (c) They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. Applicant's reply has overcome the following rejection(s): _____.

6. Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. For purposes of appeal, the proposed amendment(s): a) will not be entered, or b) will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: _____.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.

12. Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). _____

13. Other: _____.

/Melanie J Hand/
Examiner, Art Unit 3761

Continuation of 11. does NOT place the application in condition for allowance because:

1. Applicant's arguments regarding the outstanding rejections are not persuasive. With respect to arguments regarding the rejection of claims 1-9 under 35 U.S.C. 112, examiner's reference to a porous antibacterial agent refers to the porous material incorporating an antibacterial metal recited in claim 1. As there is no conflict regarding terminology that would cause confusion, it is examiner's position that it is clear that what is being referred to in the rejection is the porous material with the antibacterial material therein. This does not change the fact that there is still no support for a metal chelating agent outside of the porous material. As applicant's entire argument appears to exploit the discrepancy of terminology between the rejection and the claims without providing legitimate examples of support from the disclosure, the rejection of claims 1-9 under 35 U.S.C. 112 is maintained. The citation from the disclosure that the organic material forms salts with the sustained-release antibacterial metal is insufficient because again it is not clear from the disclosure what is meant by "outside", e.g. immediately outside, outside the solid portion of the material but within a pore, outside the compound as a whole. Elution is a process that has many phases and therefore at any time and physical position while the antibacterial metal is eluting, it is considered released or sustained-released. Therefore, depending on the intended definition of "outside", the chelating agent-antibacterial metal salt may or may not be formed outside of the porous material, i.e. the salt could be formed and rest within a pore of the material in which case it is not "outside" the porous material as that term is interpreted by the examiner.
2. With respect to arguments regarding the rejection of claims 1-9 under 35 U.S.C. 103, first the fact that applicant asserts that comparative example 2 of applicant's invention is Gancet's compound and shows poor results compared to examples 1 and 2 is immaterial. The compound of Gancet meets all of the claim limitations except those with regard to a chelating agent. Hosokawa was then introduced to remedy the deficiencies of Gancet. Second, with regard to the argument that Hosokawa does not disclose that chelating agent is added to capture eluted antibacterial metal, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).
3. In light of the lack of new or persuasive arguments placing the application in better form for appeal or in condition for allowance, the reply is not entered.